



By **Marsha K. Hoover**
August 19, 2014



MARSHA K. HOOVER IS A PARTNER AT MARSHALL, GERSTEIN & BORUN LLP WHO HAS EXTENSIVE EXPERIENCE IN TRADEMARK PROSECUTION AND COUNSELING, COPYRIGHT LAW, LICENSING AND LITIGATION FOR A DIVERSE ARRAY OF US AND INTERNATIONAL CLIENTS. SHE IS LISTED IN THE 2014 WTR 1000 RANKINGS OF TRADEMARK PRACTITIONERS BY THE WORLD TRADEMARK REVIEW.

SHE CAN BE REACHED AT 312 423 3452 OR MHOOVER@MARSHALLIP.COM.

U.S. trademark prosecution: The art of the drawing

A few decisions of the Trademark Trial and Appeal Board illustrate how the 'substantially exact' requirement can derail a registration

Applying for a federal trademark is deceptively simple. As noted in the [first article](#) in this series, the USPTO issues refusals in more than half of the filed trademark applications, and many refusals stem from a mistake in what is arguably the most fundamental element of the application: the mark.

While a mark can be a word, combination of words, a design, a combination of words and design, or a "nontraditional" mark such as a sound, a scent or a color, difficulties can arise even in applications for "standard character marks," consisting of words alone. When the applicant submits its "specimen" – a sample of how it uses the mark, the mark in the specimen must match the mark in the application. Compliance with this basic rule requires close collaboration between a company's creative team and its trademark advisors.

If the company has already started using a mark when it applies to register, the task is to accurately capture the mark in the "drawing" provided to the trademark office. If the mark has not yet been used, the challenge for counsel is to get the creative and

marketing teams to envision what the mark will look like and how it will be used, and to stick with that version. The mark in the application must be "a substantially exact representation of the mark as used on or in connection with the goods." It is difficult for creative people to resist the temptation to tweak a mark, but adding elements that change the commercial impression not only frustrates prosecution of the application, but also may take the mark beyond the scope of the pre-filing clearance search.

A few decisions of the Trademark Trial and Appeal Board illustrate how the "substantially exact" requirement can derail a registration. The applicant added the word YOUR to the mark SILENT FIREMAN and got burned in *In Re Burn Investments*. The examiner and Board both thought this was a "material alteration" of the mark. The applicant's effort to rescue its application by amending its mark to add YOUR also went up in smoke because amendments to drawings are not allowed if they constitute a material alteration.

The applicant's efforts to prove use of AT C-LEVEL by turning in

specimens showing SAN DIEGO AT C-LEVEL and C-LEVEL did not make the grade in *In re San Diego Regional Development*. Changing a mark to a slight degree was fatal in *In re Yale Sportswear Corporation*. The Board affirmed the examiner's refusal of UPPER 90 because the mark appeared as UPPER 90° on the specimen submitted. Adding a question mark to GOT STRAPS held up another applicant's plans to register in *In re Guitar Straps Online, LLC*.

If the mark shown in the specimen appears in close proximity to words or designs not included in the drawing, the USPTO may refuse registration because the applicant has "mutilated" the mark. While it is fine to break a composite mark into its component parts, the portion identified in the application must present a separate and distinct commercial impression as a trademark in and of itself. This garden variety problem cropped up in *In re Mastrondari Produce, Ltd.*, when the applicant applied for the mark MEDLEY but added a dash of glamour and used "Gourmet MEDLEY" on its package. Even though the two words were in different fonts, this did not produce a separate commercial

impression for MEDLEY, making the application ripe for rejection.

Too much space between the components of a standard character mark can also be a problem. The USPTO put a roadblock in Honda's path to register ACURA RL in *In re Honda Motor Co., Ltd.* One of the rejected specimens was a photograph of the back of the car showing the word ACURA on the left side and RL on the other; another attempt showed the two elements on the cover of the owner's manual, but displayed on different lines, in different fonts, and separated by space as well as the year date.

Standard character marks can be used in any font style, but if design choices create a new commercial impression, there is a risk of refusal. For example, *In re Supreme Steel Framing Sys. Ass'n* showed that placing the words of a standard character mark on separate "carriers" or backgrounds can be a factor in an examining attorney's conclusion that they do not combine to form a

single mark. Likewise, adding words to a design mark is a prescription for failure. In one case, the drawing was an outline of two pill bottles but the applicant submitted a photograph showing words and designs on the pill bottles. The applicant in *In re Pharmavite LLC* tried to cure the problem by arguing that the outline drawing mark was a separable background design. The TTAB affirmed the refusal because the added words and symbols superimposed on the bottles were the "defining essence" of the mark as shown on the packaging.

The requirement for harmony between the application and the evidence of use is an important reason to have a style guide. The brand owner should require that its employees and licensees comply with its rules of trademark use. An updated list of all marks for which applications have been filed should be readily available to everyone who will create packaging, advertising, press releases, websites or any other materials. All advertisements, labeling and packaging should be approved

by someone knowledgeable about the company's trademark portfolio and United States and foreign trademark requirements. When counsel recommends what seems like a very minor edit in draft materials, be aware that the change may be the difference between keeping and losing trademark rights. Any alteration of a mark should be preceded by careful consideration and undertaken only if the company is willing to risk its existing application or registration.

DISCLAIMER: The information contained in this article is for informational purposes only and is not legal advice or a substitute for obtaining legal advice from an attorney. Views expressed are those of the author and are not to be attributed to Marshall, Gerstein & Borun LLP or any of its former, present or future clients.